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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,553	01/23/2004	Jochen Von Der Hardt	010743.52910US	3212
23911	7590	06/03/2005	EXAMINER	
CROWELL & MORING LLP INTELLECTUAL PROPERTY GROUP P.O. BOX 14300 WASHINGTON, DC 20044-4300			PERRIN, JOSEPH L	
			ART UNIT	PAPER NUMBER
			1746	

DATE MAILED: 06/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/762,553

Applicant(s)

VON DER HARDT ET AL.

Examiner

Joseph L. Perrin, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-21 is/are pending in the application.
- 4a) Of the above claim(s) 1-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20050404</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Group II, claims 11-21 in the reply filed on 04 April 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Response to Arguments

2. In response to applicant's response filed 25 February 2005, the status of the application is as follows:

Oath/Declaration Objections

The objection of the Oath/Declaration is withdrawn in view of applicant's arguments.

Rejection under 35 U.S.C. §112, second paragraph

The rejection of claims 11-21 under 35 U.S.C. §112, second paragraph is maintained for reasons of record.

Rejection under 35 U.S.C. §102

Applicant's arguments re claims 11-20 have been fully considered but they are not persuasive. In response to applicant's argument that Kononov does not disclose the claimed "testing" device, this is not persuasive because Kononov clearly discloses an apparatus for cleaning and testing a filter (see entire document, for instance, the

abstract). Moreover, it is noted that applicant's arguments with respect to the apparatus of Kononov being "arranged in a completely different manner", this is not persuasive because the structure of Kononov anticipates applicant's claimed arrangement.

Rejection under 35 U.S.C. §103

Applicant's arguments re claim 21 have been fully considered but they are not persuasive. Applicant argues that since Kononov fails to disclose a filter testing device, the combination of Kononov and Phipps fail to disclose the claimed filter testing device. This is not persuasive for at least reasons of same given above with respect to Kononov.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 11-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Regarding claim 11, the word "means" is preceded by the word(s) "switching" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," (*i.e.* what is being switched?) it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159

USPQ 694 (Bd. App. 1967). Applicant is reminded of proper language for invoking 112, sixth paragraph (MPEP §2181(I)):

A claim limitation will be interpreted to invoke 35 U.S.C. 112, sixth paragraph, if it meets the following 3-prong analysis:

(A) the claim limitations must use the phrase "means for " or "step for ";

(B) the "means for " or "step for " must be modified by functional language; and

(C) the phrase "means for " or "step for " must not be modified by sufficient structure, material or acts for achieving the specified function.

With respect to the first prong of this analysis, a claim element that does not include the phrase "means for" or "step for" will not be considered to invoke 35 U.S.C. 112, sixth paragraph. If an applicant wishes to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant must either: (A) amend the claim to include the phrase "means for" or "step for" in accordance with these guidelines; or (B) show that even though the phrase "means for" or "step for" is not used, the claim limitation is written as a function to be performed and does not recite sufficient structure, material, or acts which would preclude application of 35 U.S.C. 112, sixth paragraph. See *Watts v. XL Systems, Inc.*, 232 F.3d 877, 56 USPQ2d 1836 (Fed. Cir. 2000) (Claim limitations were held not to invoke 35 U.S.C. 112, sixth paragraph, because the absence of the term "means" raised the presumption that the limitations were not in means-plus-function form, nor was the presumption rebutted.); see also *Masco Corp. v. United States*, 303 F.3d 1316, 1327, 64 USPQ2d 1182, 1189 (Fed. Cir. 2002).

6. Accordingly, in the instant case applicant's claimed "switching means" is not considered to invoke 35 U.S.C. 112, sixth paragraph, since it is unclear what function applicant is claiming. Is this limitation a means for switching the valves (*i.e.* computer/automation) or is it a means for switching the flow of the lines (*i.e.* valves)? Applicant's amendment indicating the switching means having an "open state" and "closed state" which "can be" (intended use, not a positively recited limitation) brought into or out of communication with internal volumes, does not

sufficiently provide functionality to the claimed "switching means" to invoke 35 U.S.C. §112, sixth paragraph. As best understood, for instance in view of dependent claim 17, the limitation is directed to pneumatic valves. However, clarification and correction are still required. This rejection is repeated from the previous Office action.

Claim Rejections - 35 USC § 102

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 11-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Kononov (previously cited). Re claims 11-20, Kononov discloses a device 8 having a CPU 13 controlling a plurality of pneumatic valves V1-V13 (having "an open state" and "a closed state") connecting a plurality of lines having "internal volumes" and external connections (various lines) connected to filter housing 10, a cleaning supply (top left of Figure 1), a compressed air source (top left of Figure 1) which reads on an external tank, and an internal tank (housing 10) (see Figure 1 and relative associated text, *i.e.* col. 2, line 65 *et seq.*). Recitation of Kononov reads on applicant's claimed apparatus.

Claim Rejections - 35 USC § 103

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kononov in view of Phipps, Jr. (previously cited). Recitation of Kononov is repeated here from above. Although Kononov discloses the need for sterilization of the apparatus for food and drug manufacturing standards (col. 2, lines 3-24), Kononov does not expressly disclose using steel or PTFE lines or parts. Phipps, Jr. teaches that it is known to utilize steel or PTFE (Teflon®) plumbing parts due to their inertness, *i.e.* bioresistivity (col. 6, lines 48-55). Therefore, the position is taken that a person of ordinary skill in the art at the time the invention was made would have been motivated to utilize bioresistant materials in the apparatus of Kononov in order to maintain sterilization integrity of the filter test system.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

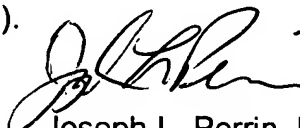
12. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph L. Perrin, Ph.D. whose telephone number is (571)272-1305. The examiner can normally be reached on M-F 7:00-4:30, except alternate Fridays.

14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael E. Barr can be reached on (571)272-1414. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Joseph L. Perrin, Ph.D.
Examiner
Art Unit 1746

jlp